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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/370,358	08/09/99	SKLAR	L UNM-MC146-UT

HM12/1130
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EXAMINER	
BRANNOCK, M	
ART UNIT	PAPER NUMBER
1646	9
DATE MAILED: 11/30/00	

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/370,358

Applicant(s)

Sklar et al.

Examiner

Michael Brannock, Ph.D.

Group Art Unit

1646



☒ Responsive to communication(s) filed on Mar 22, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-47 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-47 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-22, drawn to a methods comprising solid phase display of receptors, classified in class 436, subclass 501.
 - II. Claims 23-46, drawn to methods of presenting receptors in micelles, classified in class 435, subclass 7.2.
 - III. Claim 47, drawn to compounds, classification dependent on the chemical nature of the compound
2. The inventions are distinct, each from the other because of the following reasons:

Although there are no provisions under the section for "Relationship of Inventions" in M.P.E.P. § 806.05 for inventive groups that are directed to different methods, restriction is deemed to be proper because these methods appear to constitute patentably distinct inventions for the following reasons: Groups I and II are directed to methods that are distinct both physically and functionally, and are not required one for the other. Group I requires displaying receptors on a support, which is not required by Group II. Group II requires displaying receptors in micelles, which is not required by Group I.

Additionally, the methods of Groups I and II and the compounds of Group III are related as process of making and product made. The inventions are distinct if either or both of the

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following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the products of Group III can be obtained in ways that are materially and functionally different than each of the methods of Groups I or II because, as discussed above, each of the methods of Groups I and II are materially and functionally distinct from each other. Furthermore, depending on the identities of the compounds of Group I, many of these compounds should be available from commercial sources.

Therefore, a search and examination of all three groups in one patent application would result in an undue burden, since the searches for the groups are not co-extensive, the classification is different, and the subject matter is divergent.

3. Claims 1-47 are generic to a plurality of disclosed patentably distinct species comprising the steps of:

- a) sorting the receptor-ligand pairs by size.
- b) blocking the receptor-ligand interaction and sorting the receptor-ligand pairs by size.
- c) sorting the receptor-ligand pairs by fluorescence.
- d) blocking the receptor-ligand interaction and sorting the receptor-ligand pairs by fluorescence.
- e) sorting the receptor-ligand pairs by magnetic field.
- f) blocking the receptor-ligand interaction and sorting the receptor-ligand pairs by magnetic field.

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4. Furthermore, each method encompasses a plurality patentably distinct species of receptor, e.g., FRP, β_2 -adrenergic receptor, etc. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species of receptor, and also, a single disclosed method from the group (a)-(f) above, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Brannock, Ph.D., whose telephone number is (703) 306-5876. The examiner can normally be reached on Mondays through Fridays from 8:00 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, Ph.D., can be reached at (703) 308-6564.

Official papers filed by fax should be directed to (703) 308-4242. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

MB



November 20, 2000

Michael Brannock
Primary Examiner